

DOCKET NO. DIXI01-00015
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Paul Hayward Kelly, et al.
Serial No. : 10/678,190
Filed : October 6, 2003
For : PRODUCT SUPPORT AND DISPENSING SYSTEM
FOR A VENDING MACHINE
Group No. : 3653
Examiner : Michael E. Butler

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION PURSUANT TO 37 C.F.R. § 1.144

The above-identified application was filed with 21 total claims, of which Claims 1-16 are product claims and Claims 17-21 are method claims. Sub-combination Claims 2-9 are directed to particulars of a bail cap attached to an oscillator to selectively support product containers in a stack area of a vending machine. Sub-combination Claims 10-16 are directed to the particulars of the oscillator pivotally mounted at a lower portion of one of the vending machine stack areas. Independent Claim 1 is a combination claim including all the particulars of independent sub-combination Claims 2 and 10.

In an Office Action dated July 5, 2006, the Office set forth a three-way restriction requirement for the application. More specifically, the Office held that distinct inventions are covered by Claims 1-9, drawn to a vending machine with an adjustable bail cap, Claims 10-16

Petition Pursuant to 37 C.F.R. § 1.144
Serial No. 10/678,190
Patent

drawn to a vending machine with plural staging zones and a discharge area configured to gate variable sized products, and Claims 17-21 drawn to a method for adjusting a vending machine stack blocking outlet size.

Following a response traversing the restriction requirement between Claims 1-16, mainly arguing that combination Claim 1 links the independent subcombination Claims 2 and 10 such that restriction is improper, the Office issued a second restriction requirement in an Office Action dated October 20, 2006. This new restriction requirement now presents a four-way restriction in the application. More specifically, the Office now holds that distinct inventions are covered by combination Claim 1, sub-combination Claims 2-9, sub-combination Claims 10-16, and method Claims 17-21 respectively. In other words, the Office now considers that four separate inventions have been set forth for this application which require four separate applications.

The Applicant respectfully submits that the October 20, 2006 Office Action does not set forth a proper restriction requirement between Claims 1, 2-9 and 10-16. Accordingly, the Applicant respectfully requests the withdrawal of the restriction requirement.

In particular, it should be noted that Claim 1 requires each and every limitation of Claims 2 and 10 verbatim. If either of Claims 2 and 10 are allowable, Claim 1 would clearly be allowable. Therefore, there is no additional burden on the Office to consider Claim 1 when considering either Claims 2 or 10. In addition, in connection with examining Claim 1, the Office inherently searches and examines the subject matter of each of Claims 2 and 10. It is for this reason that the Office has set up this specific combination/sub-combination restriction practice. However, if the Office eventually determines that one of the sub-combination claims is

allowable, the Office can then appropriately restrict out the other sub-combination. Of course, the combination claim would be combined with the allowable subcombination claim.

In addition to the above, the Office continues to improperly rely upon MPEP §806.05(d) in justifying the restriction requirement. This section clearly specifies that restriction is only proper when two or more claimed sub-combinations (which are only disclosed as usable together in a single combination) do not overlap in scope and can be shown to be separately usable.

Initially, it should be noted that the application contains two claimed sub-combinations, claimed as usable together. Therefore, the combination is claimed and not simply disclosed in the specification and thus MPEP §806.05(d) does not apply. However, even if, arguendo, MPEP §806.05(d) did apply, the Office has still failed to set forth a proper restriction. MPEP §806.05(d) states that restriction is proper only if the subject matter of the claimed sub-combinations does not overlap. In the present case, each of Claims 1-16 is directed to a vending machine. Sub-combination Claims 2-9 and 10-16 require several structural limitations in common (e.g., a cabinet frame, a plurality of column walls that define stack areas and a door) all of which define, at least in part, a vending machine. Note that all of these limitations are also present in Claim 1.

Thus, the Applicant respectfully submits that the sub-combination claims clearly overlap in scope and the combination is not simply disclosed in the specification but recited in Claim 1 such that restriction under MPEP §806.05(d) is improper. It is also interesting to note that the restriction requirement presented between the combination and sub-combination claims was not made utilizing the form paragraph for combination/sub-combination restrictions outlined in §806.05(d). This form paragraph specifically recites the criteria for distinctiveness and, as set

forth above, specifically requires that the sub-combination claims to not overlap in scope and not be obvious variants.

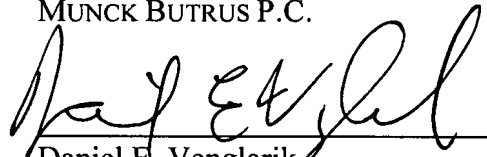
The Office also identifies Claim 17 as being a sub-combination claim disclosed as usable together in a single combination. This is not the case. Claim 17 is directed to a method of adjusting a product dispensing system for a vending machine. Accordingly, the Applicant respectfully submits that the Office has not set forth a proper restriction requirement to Group IV, method Claims 17-21.

Based on the above, the Applicant respectfully submits that the Office has not shown the two-way distinctiveness required to properly restrict combination/sub-combination claims as required by the MPEP. Thus, it is respectfully submitted that the Office Action does not set forth a proper restriction between Claims 1, 2-9, 10-16 and 17-21. Instead, it is submitted that these restrictions have been improperly made.

The Applicant therefore respectfully requests favorable reconsideration and the withdrawal of the restriction requirement.

Respectfully submitted,

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